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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/883,075 06/26/97 GOVIL S BERTEK3.0-02

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EXAMINER

WEBMAN, E

ART UNIT	PAPER NUMBER
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1617

DATE MAILED:

07/12/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/843075

Applicant(s)

Gorin

Examiner

WEBERMAN

Group Art Unit

1617

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 6/30/00
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 84, 85 is/are pending in the application.
- Of the above claim(s) 1-83 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 84, 85 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

Art Unit: 1617

Upon further review of applicants amendment to claim 84, paper #17, filed 2/14/00, to overcome the Horstmann et al reference, prosecution is reopened. The rejection over Horstmann et al is reinstated.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 84, 85 are rejected under 35 U.S.C. 102(b) as being anticipated by Horstmann et al.

Horstmann et al teach a transdermal comprising islands containing an active, wherein the the islands are obtained by spray drying solutions of active on a moisture absorbing basic material (column 3, lines 10-26). Scopalamine, a liquid, is specified (column 3, line 46). Polymers such as polyisobutylene and polyacrylic esters are disclosed (column 3 line 67-column 4 line 16).

Applicants argue that the now claimed hydrophobic polymers, in particular, those disclosed on page 15, lines 11-24, differ from those of Horstmann et al. However, applicants also disclose polyisobutylene and polyacrylic esters (page 15, line 16 and page 16, lines 3-9, respectively).

Claims 84, 85 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one

Art Unit: 1617

skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicants claim "hydrophobic" polymers but provide no support in the specification for the term. In fact, the polymers on page 15, lines 11-24, which applicants assert are hydrophobic, include polymers which are hydrophobic (polyisobutylene), hydrophilic (carboxymethyl cellulose), and water-soluble (poly vinylpyrrolidone).

This application contains claims 1-83 drawn to an invention nonelected with traverse in Paper No. 11, filed 11/16/98. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication should be directed to Edward J. Webman at telephone number (703) 308-4432.


EDWARD J. WEBMAN
PRIMARY EXAMINER
GROUP 1500